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| 20350 7590 02/26/2007 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834 | | | EXAMINER SHAY, DAVID M | |
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 12082006

Application Number: 10/600,027
Filing Date: June 19, 2003
Appellant(s): Odrich, Mark

Michael T. Rosato
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed September 28, 2006.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) *Status of Claims*

The statement of the status of claims contained in the brief is correct.

(4) *Status of Amendments After Final*

No amendments after final have been filed.

(5) *Summary of Claimed Subject Matter*

The summary of claimed subject matter contained in the brief is correct.

(6) *Grounds of Rejection to be Reviewed on Appeal*

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows:

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner:

The rejection of claims 1-15 under the judicially created doctrine of obviousness-type double patenting over claims 1-35 of U.S. Patent number 6,663,619.

The rejection of claims 10-15 under the judicially created doctrine of obviousness-type double patenting over claims 1-15 of U.S. Patent number 6,280,435.

(7) *Claims Appendix*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) *Listing of Evidence Relied Upon*

The following is a listing of the prior art of evidence (e.g. patents, publications Official Notice, and admitted prior art) relied upon in the rejection of claims under appeal.

| Number (Title) | Name | Date |
|---|------------|-------------------|
| 6,312,414 | Largent | November 6, 2001 |
| 6,027,494 | Frey | February 22, 2000 |
| Correction of High Myopia with the Excimer Laser: VISX 2015, VISX 2020, and the Summit Experience | Sher et al | 1995 |

(9) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The originally filed disclosure does not teach how to preoperatively determine the factors which are disclosed as the things beings adjusted for, as all these are set forth appear determinable only after the ablation has already taken place (see the originally filed disclosure, paragraph [0022], bridging pages 5 and 6).

Claim 1 recites the step of "adjusting an ablation cut profile..." and the only disclosure in the originally filed disclosure related to adjusting an ablation is in paragraph [0022], which

recites “adjusting the ablation to compensate for effecting the final geometry of the healed cornea.”

Claims 10-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frey in combination with Largent. Frey teaches a laser surgical system including a laser and a processor and scaling the ablation to the pupil size (see column 1, lines 5-10 and column 2, lines 46-55). Largent teaches designing a corneal ablation to mitigate presbyopia. It would have been obvious to the artisan of ordinary skill to employ the device of Frey on a subject with presbyopia, since this condition is correctable with laser sculpture as taught by Largent, or to employ the pupil scaling device of Frey in the presbyopia treating system of Largent, since this would reduce the halo effect and improve night vision, as taught by Frey, thus producing a device such as claimed.

(10) Response to Argument

A. The Propriety of the Rejection official notice of which is hereby taken, Claims 1-9 Under 35 U.S.C. 112, First Paragraph

Appellant argues that the subject matter of claims 1-9 are sufficiently described in the originally filed application by virtue of the existence of the claims therein. The examiner respectfully submits that the mere existence of claims, standing alone, is an insufficient basis for enablement. For example, if an patent application were filed containing claims which recited only an antigravity device, with no disclosure concerning the component parts or the arrangement and construction thereof, this would not be enabling, despite the existence of the claims in the originally filed application. Appellant also makes reference to “the strong presumption of adequate written description”, however provides no authority upon which to base this statement. Indeed the mere inclusion of claims in the originally filed application has been

shown to be insufficient to provide enablement, see *LizardTech, Inc. v. Earth Resource Mapping, Inc.*, 424 F.3d 1336, 1345, 76 USPQ2d at 1724, 1733 (Fed Cir. 2005), cited in MPEP 2163(I).

Appellant having previously argued that the claims were adequately supported, and as additional evidence of the examiner's position the article to Sher et al was provided, which clearly shows great variability in the healed corneal curvature compared to the desired or predicted final curvature. This is clear from the fifth full paragraph in the first column on page 78, showing a mean variation of 2.1 Diopters, and the graph in Figure 6-1, showing variations as high as 4 Diopters in the various surgical outcomes; from the third paragraph in column 2 on page 81, discussing only 74% of the patients being within 2 Diopters of the attempted correction; and a subsequent study, discussed in the third paragraph in column 2 on page 82, discussing only 50% of the patients being within 2 Diopters of the attempted correction; and lastly the full paragraph in column 2, on page 85, and Figure 6-9 on page 86 show a wide variation in refractive outcome (up to plus or minus 2 Diopters). This evidence remains unrebutted by any factual showing on appellant's part.

B. The Propriety of the Rejection of Claims 10-15 Under 35 U.S.C. 103 as obvious over Largent in combination with Frey.

Regarding the obviousness rejection, appellant argues that the examiner has not established a *prima facie* case of obviousness. Firstly, appellant asserts that the examiner has not provided a motivation to combine the references. The examiner must respectfully disagree. A motivation has been clearly articulated: employing the scaling of Frey in the device of Largent would improve night vision, this advantage is expressly stated in Frey (see the last sentence in the Abstract), similarly, Frey discloses no particular type of photorefractive correction to employ with his scaling device, thus any photorefractive recurvature device which could provide a useful

correction (such as the device of Largent) would be used therewith. Thus appellant's assertions of lack of motivation are not well founded. In the discussion of the various teachings of Frey and Largent, appellant describes the teachings of Largent as a "one size fits all" outer ablation shape (see the instant Brief, page 10, second sentence of the final paragraph). However, Largent discusses no particular size at all, nor does Largent anywhere mention that the outermost ablation diameter must be given size, or even a range of sizes. Thus it is unclear from whence appellant has determined this description of Largent, as it does not appear to derive from the Largent reference.

Appellant then argues that one of ordinary skill in the art would not understand the necessity of providing useful corrections for all the distance corrections ablated into the cornea, arguing that the examiner's analogy to the adjustment of spectacle lenses is flawed. The examiner must respectfully note that Largent specifically states that "[T]he specific configuration of the power curve across the cornea can be tailored to suit the needs of the patient and the particular design considerations" (see column 1, lines 57 to 59). Thus clearly adjustment of all the curvature zones is contemplated in the disclosure of Largent, and is so well known to one of ordinary skill in the art that not even one example of how this would be accomplished is given. Given that claim 1 of Largent recites a "method of vision correction comprising ... directing the modulated laser beam to the cornea of a patient to ablate a region of the cornea to different degrees to provide the cornea with different progressive vision correction powers" and given the Largent is an issued U.S. Patent, the presumption of validity which Largent is due requires the assumption that the tailoring "to suit the needs of the patient", so as to provide a "method of vision correction" as claimed, one must conclude that one of ordinary skill in the art

is quite capable of providing the ratios of the various curvature regions, especially in view of the fact that Largent supplies no ratios at all.

C. & D. Rejections Under the Judicially Created Doctrine of Obviousness-Type

Double Patenting

These rejections have been withdrawn and thus the arguments concerning them are moot.

(11) *Related Proceedings Appendix*

NONE

(12) *Conclusion*

It is the examiner's firm opinion that the appealed claims are not patentable for the reasons argued above. Appellant has presented no convincing argument as to why the rejections set forth above are not obvious or proper. Therefore, it is respectfully submitted that the final rejection be affirmed

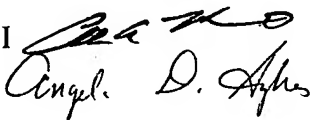
Respectfully submitted,



DAVID M. SHAY
PRIMARY EXAMINER
GROUP 330

David Shay
December 11, 2006

Conferees
Charles Marmor, II
Angela Sykes
David Shay



TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California, 94111-3834